

**Remarks**

By the foregoing Amendment, claim 1 is amended, and claims 7–18 are added. Entry of the Amendment, and favorable consideration thereof, is earnestly requested.

The present invention relates to a medical instrument with a hollow shaft 2 on whose proximal end a handle 3 is mounted, which consists at least of a stationary gripping member 3a and gripping member 3b that is rotatable in relation to the stationary gripping member 3a. (10/626,414: Par. 22.) At the distal end of the shaft 2, a tool 4 is mounted, which has a rotatable jaw member 4a and a jaw member 4b that is rigidly connected to the shaft 2. (Id.) The jaw member 4 and the gripping member 3 of the handle are connected with one another by means of a push pin 5, mounted in the hollow shaft. (Id. at Par. 23.) The push pin 5 is secured at least partly in form-locking connection, into a rigid casing 12, which in turn can be inserted, as least in some sections form-locking connection, into the hollow shaft and the push pin can be installed in the casing, with at least section of it being rotation resistant. (Id. at Par. 8.)

Falk discloses arthroscopy hook-clippers comprising a casing 3, 7 (tubes 3 and 7) with a circular cross section with a tool member 4 at the distal end, wherein a push pin 9 (thrust rod) extends through the casing 3 for displacing the tool member 4, and a hollow vacuum tube 7 extends through the casing 3 beside the push pin 9. The push pin further has a gripper member at its proximal end. The casing 3 has at its proximal end, a male coupling element 5 for exchangeable connection to a fixed arm 1a of a handle 1. (Falk: Col. 2, Ins. 9–15.)

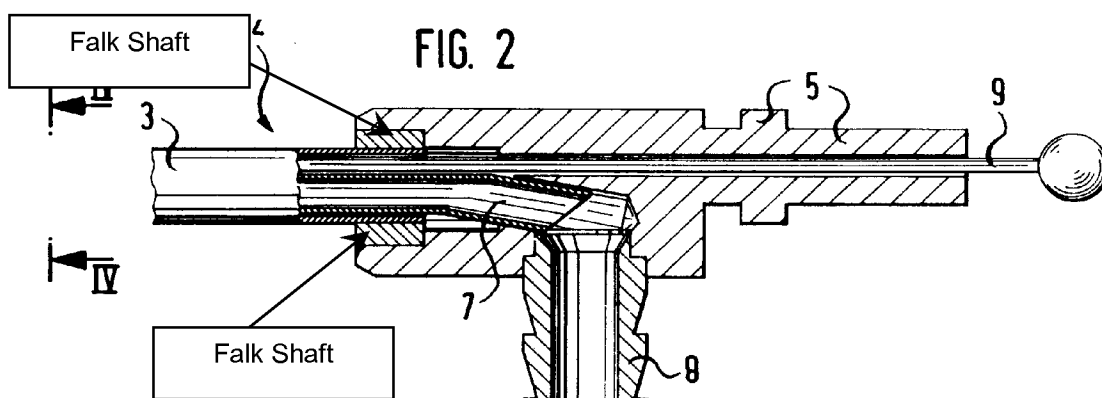
The Applicants note that they have added new independent claim 7 and depending claims 8–12. Independent claim 7 includes all of the limitations of independent claim 1, and further includes the limitation that the hollow shaft and the push pin are substantially the same length. The Applicants further note that they have added new

independent claim 13 and depending claims 14–18. Independent claim 13 includes all of the limitations of independent claim 1, and further includes the limitation that the hollow shaft and the rigid casing are substantially the same length.

Claims 1–6 Rejected Under 35 U.S.C. § 102(b) by Falk

The Examiner has rejected claims 1–6 under 35 U.S.C. 102(b) as being anticipated by Falk, U.S. Patent No. 4,994,024. The Applicants respectfully submit that claims 1–18 are not anticipated by Falk and respond accordingly.

Falk does not anticipate the present invention as claimed in claim 1 because Falk is missing a shaft having at its proximal end a handle consisting of at least two gripping members and at its distal end a tool consisting of at least two jaw members as required by all pending claims. The Examiner indicates that Falk discloses a shaft, wherein the shaft is sandwiched between tube 3 and element 5. (The Falk shaft is labeled by the Applicants in the reproduction of Fig. 2, shown below, however is not labeled in the Falk disclosure.)



The Falk shaft is not labeled in any Figure of the Falk patent. Moreover, the Falk shaft is not described in the specification of the Falk patent, with the exception of Fig. 2.

The Applicant notes that the Falk disclosure repeatedly refers to a “shaft 3,” however in the context of the present action; the Examiner has indicated that “shaft 3” comprises a portion of the casing as required by independent claim 1 of the present disclosure.

Falk does not anticipate the present invention as claimed in claims 1–18 because Falk is missing a hollow shaft having at its proximal end a handle consisting of at least two gripping members and at its distal end a tool consisting of at least two jaw members. The Falk shaft, as disclosed above in the representation of Fig. 2 of Falk is missing a handle consisting of at least two gripping members at its proximal end. The Falk Shaft has a male coupling element 5 located at its proximal end. (Falk: Col 2, Lns. 12–13.) (see also Falk Fig. 2.) The male coupling element 5 can exchangeably connect to a fixed arm 1a of a handle 1 by means of a female coupling element 6, which is provided with a locking screw. (Falk: Col. 2, Lns. 9–15). The Falk shaft is further missing a tool consisting of at least two jaw members located at its distal end. (Falk: Fig. 2.) Falk discloses that the Falk shaft has a casing 3,7 located at its distal end.

#### New Claims 7–12

Falk does not anticipate claims 7–12 because Falk is missing a hollow shaft having at its proximal end a handle consisting of at least two gripping members and at its distal end a tool consisting of at least two jaw members as discussed above. Falk is further missing a push pin 9 and a hollow shaft (not labeled in Falk) that are substantially the same length. (Falk: Fig. 2). The Falk shaft is merely a connection piece in which the proximal end of the casing 3, 7 is inserted. (Id.) The push pin 9 is substantially longer ( $\approx 20 \times$ ) than the Falk shaft (unlabeled) as it extends past the shaft in both directions. (Falk: Fig. 2.)

#### New Claims 13–18

Falk does not anticipate claims 13–18 because Falk is missing a hollow shaft having at its proximal end a handle consisting of at least two gripping members and at its distal end a tool consisting of at least two jaw members as discussed above. Falk is further missing a casing 3,7 and the hollow shaft (not labeled in Falk) that are substantially the same length. (Falk: Fig. 2). The Falk shaft is merely a connection piece in which the proximal end of the casing 3, 7 is inserted. (Id.) The casing is substantially longer than the Falk shaft (unlabeled) as it is readily evident in Fig. 2. (Falk: Fig. 2.)

#### Not Obvious to Modify the Falk Shaft

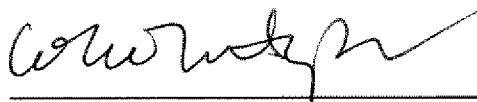
There is not motivation to modify the Falk shaft (unlabeled) to arrive at the claimed invention. The Falk shaft merely serves as a connecting piece, or washer, in which to receive the proximal end of the casing. (Falk: Fig. 2) It appears in Fig. 2 that the Falk shaft may secure the casing 3, 7 against rotation, but there is no definitive indication of this limitation in Falk. Moreover there is no teaching, suggestion, or motivation to extend the Falk shaft to the distal end of the casing where the jaw members are attached. In fact, it is well known that a thinner shaft is preferred as there is less potential to negatively affect tissue during use. One having ordinary skill in the art would not be motivated to extend the Falk shaft to the gripping members, thereby increasing the overall diameter of the shaft, and thereby increasing the risk to the patient.

There is further not motivation to modify the Falk shaft (unlabeled) to arrive at the present invention. As stated above the Falk shaft serves merely as a connecting piece or washer to receive the proximal end of the casing. The Falk shaft holds the casing in place, where it connects to element 5. There is no motivation to attach grippers or a handle at either end of the Falk shaft because it would cease to serve its purpose as a connecting piece. Furthermore, there is no motivation to extend the Falk shaft for the same reason.

For the foregoing reasons, Applicant respectfully submits that all pending claims, namely Claims 1–18, are patentable over the references of record, and earnestly solicits allowance of the same

Respectfully submitted,

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